

Serial No. 10/022,655  
Amendment dated October 19, 2004  
Reply to Office Action of July 29, 2004

### **REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed July 29, 2004. In the Office Action, the Examiner notes that claims 3-21, 24, 25, 27, 29, 31, 33 and 35 are pending, of which all the pending claims are rejected under 35 U.S.C. §103.

By this response, Applicants have amended 5, 18, 19, and 20 to define more clearly an aspect of Applicants' invention.

In view of the amendments described above and the following discussion, Applicants submit that the claims pending in the application are believed to be nonobvious under 35 U.S.C. §103. Thus, Applicants believe that the application is in condition for allowance.

### **I. AMENDMENT TO CLAIMS**

Claims 5 and 18 have been amended to recite positively the step of determining whether the channel tune count indicator for a channel in the list falls below the view threshold value. This step was implied in the removing step where removal occurs when the "associated channel tune count indicator falls below a view threshold value." Accordingly, the amendment to these claims is proper and justified.

Claim 19 has been amended to recite positively the means for determining whether the channel tune count indicator for a channel in the list falls below the view threshold value. This means was implied in the removing means where removal occurs when the "associated channel tune count indicator falls below a view threshold value." Thus, the amendment to this claim is proper and justified.

Claim 20 has been amended to recite positively that the favorite selection software is operative to determine whether the channel tune count indicator for a channel in the list falls below the view threshold value. This operation was implied in the remove operation where removal occurs when the "associated channel tune count indicator falls below a view threshold value." Thus, the amendment to this claim is proper and justified.

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## **II. REJECTIONS UNDER 35 U.S.C. §103**

Applicants acknowledge that they have been advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

### **A. Rejection of Claims 3-8, 18-21 and 27 in view of Candelore and Bates**

Claims 3-8, 18-21 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0104081 of Candelore et al. (hereinafter "Candelore") in view of U.S. Patent 6,721,953 to Bates et al. (hereinafter "Bates"). In view of the amendments to the claims, Applicants respectfully traverse the Examiner's rejection.

Applicants teach and claim a method in which the list of automatic favorite channels is "aged" whether or not the list is full and whether or not a new favorite channel is seeking inclusion in that list. Failure to watch that favorite channel during a time period causes the corresponding entry in the favorites list to remain at the same value (i.e., unincremented), which, in turn, causes that favorite to be decremented automatically if the time period exceeds a predetermined period. There is no other stimulus needed to perform Applicants' decrementing step. Decrementing occurs after it has been determined that the so-called "channel tune count indicator in the list of automatic favorite channels" falls below a "view threshold value." It should be understood that failure to watch all the favorite channels in the list for a long enough period of time would cause Applicants' claimed list of automatic favorites to be emptied entirely by virtue of repeated applications of the claimed determining, aging, and removing steps.

Candelore does describe a decrementing step for his method and system. But decrementing by Candelore is not done because it has been determined that "the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value". Decrementing by Candelore is also not done "automatically ... when the channel tune count indicator for a channel associated

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with the any identifier is not incremented within a time period that exceeds a predetermined period." Both of these limitations are clearly claimed by Applicants.

Instead, Candelore decrements the count values in anticipation of a so-called "rollover condition" that occurs when the count value for the highest ranking favorite in the list is so high in value that a single up-tick will cause the count value for that favorite to be incremented to an all zero condition. That is, a maximum count value will be incremented once to the minimum count value. When this rollover condition is detected, Candelore reduces the count for every channel in the list so that the relative positions of the count values are at least maintained.

Candelore's decrementing step has nothing to do with viewing inactivity for a period of time. In fact, it is concerned with just the opposite — viewing activity. Viewing activity, not inactivity, causes the count value of one favorite to reach a maximum value and be in jeopardy of a rollover if the viewing continues and the count is incremented. In order to keep rollover from occurring, the particular count value is decremented by some amount. All other count values, in one example, are also decremented by that amount. Thus, it is the viewing activity associated with one particular channel that causes all the other channel count values in the list to be decremented. Candelore's system does no inquiry to determine whether the entries being decremented have been viewed in a given time period. The only criteria for decrementation are that the entries have to be on the list and one entry (the one being viewed) has reached a maximum count value putting it in jeopardy of a rollover condition. Accordingly, Candelore cannot be said to teach, show, or suggest Applicants' unique invention including the step of aging by decrementing as defined in claims 5 and 18, a means for aging by decrementing as defined in claim 19, and the software functionality to age by decrementing as defined in claim 20.

Bates does not bridge the substantial gap between Candelore and Applicants' invention. Bates discloses methods for displaying television program information using a dynamically adjusted scroll rate. With respect to a process shown in Fig. 6 of the patent at col. 8 beginning at line 26, Bates discusses aging the data in table 50 as follows:

*Moreover, in some embodiments, table 50 may be kept at a fixed maximum size, with programs having the lowest counts periodically*

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*deleted as new favorite programs are found. Other manners of "aging" the data, e.g., periodically decrementing the counts for older entries, may also be used to emphasize programs that have been watched more recently than others.*

Bates fails to disclose the claimed steps of (or means for or operations of) "determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value" and "removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value." Bates shows no threshold values or elements for determining whether a count falls below that threshold. Further, while Bates does show deletion of certain entries in the table, Bates does not delete entries based on their association with a decremented value that falls below a threshold. Instead, when Bates needs room in the table, he suggests deletion of the entries having the lowest counts. There is no comparison to a threshold at all. Deletion is solely based on being an entry at the bottom of the table sorted by count. There is no guarantee that the entry at the bottom of such a listing in the table would have a value below some set threshold because the count for an entry at the end of a list can be very large or very small. There is no way to predict its value, except to say that, in the list at hand, the entry at the bottom of the list has the lowest value. This is not Applicants' claimed invention. Therefore, the combination of Candelore and Bates still fails to teach, show or suggest Applicants' invention as a whole.

In light of the remarks above, Applicants' invention as defined by amended independent claims 5 and 18-20 would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore and Bates, separately and in combination, at the time the invention was made. Therefore, it is submitted that independent method claim 5, computer readable media claim 18, and system claims 19 and 20 are allowable under 35 U.S.C. §103.

Claims 3, 4, 6, 7, 8 and 27 depend, either directly or indirectly, from independent claim 5. For the same reasons discussed above with respect to amended independent claim 5, Applicants submit that dependent claims 3, 4, 6, 7, 8 and 27 also are allowable under 35 U.S.C. §103.

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Claim 21 depends directly from independent claim 20. For the same reasons discussed above with respect to amended independent claim 20, Applicants submit that dependent claim 21 is allowable under 35 U.S.C. §103.

**B. Rejection of Claims 9-14, 29, 31 and 33 in view of Candelore, Bates and Ohkura**

Claims 9-14, 29, 31 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore in view of Bates and further in view of U.S. Patent 5,737,029 to Ohkura et al. (hereinafter "Ohkura"). Claims 9-14, 29, 31 and 33 are dependent, either directly or indirectly, upon Applicants' independent claim 5. Applicants respectfully traverse the instant rejection.

It has already been discussed above in Section II.A that Candelore and Bates fail to teach, show, or suggest Applicants' method steps as defined in claim 5 as a whole. Similarly, the Ohkura references fail to teach at least Applicants' steps of "determining whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value" and "removing from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold value."

Ohkura is concerned with creating an automatic favorites list, and he wants to exclude channels that are viewed for a short duration such as less than five minutes. It is important to note that these are channels that are being excluded from entry onto the favorites list. Ohkura presents no teaching, showing, or suggestion for checking an entry already on the list to determine whether its viewing time is of a short duration. That teaching is only found in Applicants' specification. Therefore, Ohkura, when added to the teachings of Bates and Candelore, falls far short of the invention defined in Applicants' claim 5.

Since claims 9-14, 29, 31, and 33 depend directly or indirectly from claim 5 and since amended claim 5 is believed to be allowable over Candelore, Bates and Ohkura, either alone or in combination, Applicants respectfully submit that claims 9-14, 29, 31, and 33, dependent directly or indirectly from claim 5, are also allowable over these

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references. Therefore, it is believed that claims 9-14, 29, 31, and 33 are allowable under 35 U.S.C. §103.

**C. Rejection of Claims 13, 15, 16 and 25 in view of Candelore, Noguchi and Bates**

Claims 13, 15, 16 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore and Bates in view of to Noguchi et al. (hereinafter "Noguchi"). The rejected claims depend either directly or indirectly from independent base claim 5. Applicants respectfully traverse the rejection.

As discussed above, Applicants submit that independent claim 5, and therefore the claims dependent thereon, is patentable and non-obvious under 35 U.S.C. §103 in view of Candelore and Bates. Noguchi fails to bridge the substantial gap as between Candelore and Bates and Applicants' invention.

It has already been discussed above that Candelore and Bates fail to teach Applicants' method step of aging as defined in independent base claim 5. As discussed immediately above, Noguchi fails at the outset to teach Applicants' method step of aging as defined in claim 5.

Noguchi teaches a system for displaying an electronic program guide on a monitor, such as a television screen. Noguchi shows a remote control device having a number of different controls, one of which is a "favorites" control. The favorites control allows the user "to designate certain programs as favorite programs." This control also permits "selection of favorite programs." There is no teaching in Noguchi about aging entries in the favorites list when they have not been watched for a certain time period or about determining whether indicators in the favorites list fall below a prescribed threshold or about removing entries from the favorites list if their indicators fall below the threshold, all as taught and claimed by Applicants in the independent base claim. As a result, the addition of Noguchi's teachings to the teachings of Candelore and Bates, even if such addition is properly motivated by the references alone, falls short of teaching, suggesting, or showing Applicants' unique method as a whole.

In light of the remarks presented above with respect to independent base claim 5, it is submitted that the Candelore, Bates and Noguchi patents fail to teach,

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show, or suggest Applicants' invention as defined in base claim 5 and in dependent claims 13, 15, 16, and 25. As a result, it is submitted that Applicants' claimed invention would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates, and Noguchi, separately and in combination, at the time the invention was made. Therefore, Applicants believe that dependent claims 13, 15, 16 and 25 are allowable under 35 U.S.C. §103.

**D. Rejection of Claims 17 and 35 in view of Candelore, Bates and McClard**

Claims 17 and 35 stand rejected as being unpatentable under 35 U.S.C. §103(a) over Candelore and Bates in view of U.S. Patent 6,438,752 B1 to McClard (hereinafter "McClard"). Claims 17 and 35 depend directly and indirectly from independent base claim 5. This rejection is respectfully traversed.

McClard teaches a system for storing and selecting favorite programs tailored for each individual user. As programs are watched, they are placed in a list of favorites. McClard discusses populating the list and selecting programs/channels from the list. But McClard teaches nothing about aging the list as taught and defined by Applicants in claim 5. Moreover, McClard teaches nothing about both determining whether indicators for certain entries on the favorites list fall below a threshold and then removing those certain entries from the list.

It has already been discussed in Section II.A above that Candelore and Bates fail to teach Applicants' method steps as defined in independent base claim 5. As discussed immediately above, McClard fails at the outset to teach Applicants' method as defined in claim 5. As a result, it is believed that the combination of Candelore, Bates and McClard fails to teach, show, or suggest Applicants' claimed invention.

In view of the remarks immediately above and those remarks not repeated herein with respect to Candelore and Bates above, it is respectfully submitted that Applicants' invention as defined by dependent claims 17 and 35, dependent directly or indirectly from amended independent base claim 5, would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates and McClard, separately or in combination, at the time the invention was made. Therefore,

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Applicants respectfully submit that claims 17 and 35 are allowable under 35 U.S.C. §103.

**F. Rejection of Claim 24 in view of Candelore, Bates, and Florence**

The Examiner has rejected claim 24 under 35 U.S.C. §102(e) as being unpatentable over Candelore and Bates in further view of U.S. Patent Application Publication No. 2002/01888948 (hereinafter "Florence"). Claim 24 depends directly from claim 5. Applicants respectfully traverse the rejection.

Florence describes a set top box that is capable of storing channel favorites in a channel favorites table and for displaying the list of stored channel favorites for a viewer. Favorites are based on computed cumulative viewing time. But Florence fails to teach, show, or even remotely suggest aging the favorites list as taught and claimed by Applicants. In addition, Florence fails to teach, show, or even remotely suggest both determining whether indicators for certain entries on the favorites list fall below a threshold and then removing those certain entries from the list.

It has already been discussed above that Candelore and Bates fail to teach Applicants' method as defined in Independent base claim 5. As discussed immediately above, Florence fails at the outset to teach Applicants' method as defined in claim 5. Since Florence does not teach, show, or suggest the aging, determining and removing steps, the addition of the teachings of Florence to Candelore and Bates does not cure the infirmities of either Candelore or Candelore and Bates. The combined teachings of Florence, Bates and Candelore fail to teach, show, or suggest Applicants' unique invention.

In view of the remarks above, Applicants respectfully submit that claim 24 would not have been obvious to a person having ordinary skill in the art upon a reading of Candelore, Bates and Florence, separately or in combination, at the time the invention was made. Therefore, Applicants believe that claim 24 is allowable under 35 U.S.C. §103.



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#### **VI. REFERENCES NOT APPLIED**

The additional references of Rothmuller and Trovato et al. have been cited, but not applied. After reviewing these references, it is believed that these references are cumulative to the primary references cited and applied in the Office Action. Therefore, Applicants believe that a detailed discussion of the cited references is not necessary for a full and complete response to this Office Action.

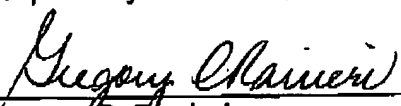
#### **CONCLUSION**

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Reconsideration of this application and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Gregory C. Ranieri, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: October 19, 2004

  
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**CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8**

I hereby certify that this correspondence is being transmitted by facsimile under 37 C.F.R. §1.8 on Tuesday, October 19, 2004 and is addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No. (703) 872-9306.

C. Wilson  
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October 19, 2004  
Date of signature